

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : Eskuchen et al.
Appl. No. : 09/402,232
Filed : 09/30/99
Title : THE PROCESS FOR PREPARING ALKYL AND/OR ALKENYL
OLIGOGLYCOSIDES

Grp./A.U. : 1623
Examiner : L. Maier

Docket No. : H 2849 PCT/US

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, DC 20231, on June 28, 2001.

June 28, 2001
Date

Marlene Capreri
Signature of certifier

Marlene Capreri
Typed or printed name of certifier

APPEAL BRIEF TRANSMITTAL

Commissioner for Patents
Washington, DC 20231


Sir:

Appellants' brief, in triplicate, is transmitted herewith in accordance with 37 CFR §1.192.

Please charge the required fee of \$310.00 to our Deposit Account No. 50-1177. This paper is enclosed in triplicate. Order No. 01-0398.

The Commissioner is hereby authorized to charge any deficiency in the required fee or to credit any overpayment to Deposit Account 50-1177.

Respectfully submitted,


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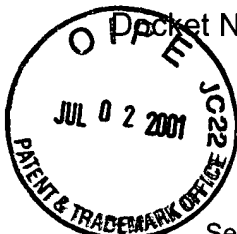
TECH CENTER 1600/2900

#1377

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Washington, DC 20231

BRIEF ON APPEAL UNDER 37 C.F.R. 1.192

Sir:

REAL PARTY IN INTEREST

The real party in interest is Cognis Deutschland GmbH, Henkelstrasse 67, 40589 Duesseldorf, Germany.

RELATED APPEALS AND INTERFERENCES

None.

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STATUS OF CLAIMS

Claims 11-24 are the subject of this appeal.

STATUS OF AMENDMENTS

No amendments were made after final rejection.

SUMMARY OF THE INVENTION

Briefly stated, the present invention is directed to a process for making alkyl or alkenyl oligoglycosides by first mixing glucose sirup and a fatty alcohol to form a suspension, adding an acidic catalyst to the suspension to form a mixture, and then acetalizing the mixture to form the oligoglycosides. See page 2, lines 7 to 15.

ISSUES

Whether claims 11-13, 16-18, 21, 22 and 24 are anticipated under 35 U.S.C. § 102(b) by Carduck et al., US 5,554,741.

Whether claims 11-24 are obvious under 35 U.S.C. § 103(a) over Carduck et al., US 5,554,741.

GROUPING OF THE CLAIMS

The claims stand and fall together.

ARGUMENT

Carduck '741 fails to anticipate the claimed invention on the grounds that it fails to disclose each and every element thereof.

Appellant would first like to note that it is well settled in the law that a factual

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determination of anticipation requires the disclosure, in a single reference, of each and every element of a claimed invention, and an Examiner must identify wherein each and every facet of the claimed invention is disclosed in the applied reference. See, In re Levy, 17 USPQ2d 1561 (Bd. Pat. App. & Inter. 1990).

Appellant respectfully submits that the Carduck reference fails to anticipate the claimed invention on the grounds that it fails to disclose each and every element thereof. More particularly, the process of the present invention involves the use of an aqueous glucose sirup which is mixed with a fatty alcohol followed by the addition of an acid catalyst and subsequent acetalization of the aqueous glucose sirup/fatty alcohol suspension.

The Carduck reference, on the other hand, **requires** that its glucose sirup/fatty alcohol suspension be free of water, **prior to acetalization**, see col. 3, lines 5-51. The Examiner has noted that the glucose sirup employed by the present invention is consistent with the definition of glucose sirup disclosed in the Carduck reference. While Appellant agrees with the Examiner's observation, it is noted that at no point during the claimed process is water removed from Appellant's claimed suspension, **prior to acetalization**. In the Carduck reference, on the other hand, it is seen in col. 3, lines 24-31, that Carduck **removes water** from its glucose sirup/fatty alcohol suspension **prior to acetalization**. Consequently, since this acetalization of a glucose sirup/fatty alcohol suspension which contains water is **NOT DISCLOSED** by the Carduck reference, it cannot serve to anticipate Appellant's claimed invention.

Carduck '741 fails to render the claimed invention obvious on the grounds that it fails to contain any teaching or suggestion which might motivate a person of ordinary skill in the art to modify its teaching in a manner which would read on the claimed invention.

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Appellant would first like to note that it is clear in the law that, to establish a prima facie case of obviousness under 35 U.S.C. § 103(a) based upon a single reference, the Office must show an art-recognized motivation to modify the reference in the manner asserted by the Office. See, In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

This being the case, Appellant respectfully submits that the Carduck reference fails to render the claimed invention prima facie obvious on the grounds that it fails to contain any teaching or suggestion which would motivate one of ordinary skill in the art to keep the water in the glucose sirup/fatty alcohol suspension prior to acetalization, as is presently claimed, rather than remove the water as is taught by the Carduck reference at col. 3, lines 24-31. Clearly, the removal of water from the glucose sirup/fatty alcohol suspension is a required element of Carduck's invention.

Moreover, Appellant would also like to note that it is equally well settled in the law that one important indicium of non-obviousness is the **teaching away** from the claimed invention by the prior art. See, In re Braat, 16 USPQ2d 1812 (Fed. Cir. 1990). Appellant respectfully submits that based on Carduck's clear teaching that water be removed from the glucose sirup/fatty alcohol suspension **prior to acetalization**, rather than left in as is disclosed by the claimed invention, this reference serves to establish the **non-obviousness** of Appellant's invention by clearly **teaching away** therefrom.

SUMMARY

Carduck '741 fails to anticipate the claimed invention on the grounds that it fails to disclose each and every element thereof.

Carduck '741 fails to render the claimed invention prima facie obvious on the grounds that it fails to contain any teaching or suggestion which would motivate one skilled in the art to modify its teaching in a manner which would read on the claimed invention.

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It is requested for the reasons given above, that the Board find for Appellant on all of the issues, and reverse the Examiner's Final Rejections.

Respectfully submitted,



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APPENDIX

CLAIMS ON APPEAL

11. A process for making alkyl and/or alkenyl oligoglycosides comprising:
 - (a) providing an aqueous glucose sirup;
 - (b) providing a fatty alcohol;
 - (c) combining the glucose sirup with the fatty alcohol in order to form a glucose sirup/fatty alcohol suspension;
 - (d) providing an acidic catalyst;
 - (e) adding the acidic catalyst to the glucose sirup/fatty alcohol suspension;
 - and
 - (f) acetalizing the glucose sirup/fatty alcohol suspension containing the acidic catalyst to form the alkyl and/or alkenyl oligoglycosides.
12. The process of claim 11 wherein the glucose sirup has a solids content of from 50 to 85% by weight, based on the weight of the glucose sirup.
13. The process of claim 11 wherein the glucose sirup has a monomeric glucose content of from 80 to 99.9% by weight, based on the weight of the glucose sirup.
14. The process of claim 11 wherein the glucose sirup of (a) is in supercooled melt form.
15. The process of claim 11 wherein the fatty alcohol of (b) is preheated to a temperature of from 25 to 40°C.

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16. The process of claim 11 wherein the fatty alcohol corresponds to formula (I):



wherein R¹ is an aliphatic, linear or branched hydrocarbon radical having from 6 to 22 carbon atoms, and up to 3 double bonds.

17. The process of claim 11 wherein the glucose sirup and fatty alcohol are combined in a molar ratio of from 1:1 to 1:10.

18. The process of claim 11 wherein the catalyst is added to the glucose sirup/fatty alcohol suspension in an amount of from 0.1 to 5% by weight, based on the weight of the suspension.

19. The process of claim 11 wherein the process is carried out discontinuously in a stirred tank reactor.

20. The process of claim 11 wherein the process is carried out in a cascade of from 3 to 6 stirred reactors.

21. The process of claim 11 wherein the glucose sirup/fatty alcohol suspension is dried prior to acetalization.

22. The process of claim 20 wherein the cascade of stirred reactors has a temperature gradient of from 70 to 120°C.

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23. The process of claim 20 wherein the cascade of stirred reactors has a pressure gradient of from 20 to 50 mbar.

24. The process of claim 11 wherein acetalization is carried out under reduced pressure.